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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Bart Victor et al.

Serial No.: 09/772,810

Filed: January 30, 2001

For: **METHOD AND MATERIALS FOR ENCOURAGING
CREATIVE THINKING, PLANNING OR DECISION MAKING**

Art Unit: 3712

Examiner: Kurt Fernstrom

Pitney Hardin LLP
7 Times Square
New York, New York 10036-7311

PETITION TO DIRECTOR UNDER RULE 181(a)(1)

Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

SIR:

Applicant petitions to the Director under Rule 181(a)(1) with respect to actions and requirements of the Examiner in the prosecution of the above application.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed: Commissioner of Patents and Trademarks, P.O. Box 1450, Alexandria, VA 22313-1450, on October 11, 2006

Ronald E. Brown

Attorney

Signature

October 11, 2006

Date of Signature

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Account No. 50-1145, Order No. 3977-8

STATEMENT OF FACTS

1. The presently claimed invention relates to enhancing the thinking process of individuals and more particularly to a program, method and materials for encouraging creativity and enhanced communication, strategic planning and decision-making among employees of a company.

2. The single independent claim (Claim 1) of this application recites using “building blocks to serve as physical metaphors”. Similarly, Claim 2 recites, in part, “the topic involves business planning”. Claim 3 recites, in part, “at least one of the metaphors represents an aspect of a company and at least one of the metaphors represents a customer of a company”. Claim 4 recites, in part, “wherein the participants are caused to create physical links between the physical metaphors representing the company and its customers”. Claim 14 recites, in part, “wherein at least one of the metaphors represents an aspect of a company and the participants construct models representing guiding principles for governing how to address changes in the way the company implements its business strategy”.

3. The applicants filed an appeal brief to the Board of Patent Appeals and Interferences in this matter. The issues in this appeal brief were 35 U.S.C. §101 and 35 U.S.C. §112, first and second paragraphs.

4. On April 12, 2006, the Examiner re-opened prosecution by way of a **non-final** Office Action which included rejections under 35 U.S.C. §101 and 35 U.S.C. §112, first paragraph, and

which further rejected the claims under 35 U.S.C. §102 as anticipated by an article in The Technology Teacher titled “TECHNOTOWN-A School-Wide Design Technology Project”.

5. The non-final Office Action of April 12, 2006 further included a Request for Information with respect to the TECHNOTOWN reference, requiring the Applicant under Rule 105 “to provide all relevant information of reference similar in nature to the Technotown reference for the examination of this application.”

6. Upon reviewing the Technotown reference, the Applicants determined that the TECHNOTOWN reference essentially related to supplying large quantities of LEGO building blocks to young school students and had nothing to do with the business planning aspects of the presently claimed invention as discussed in numbered paragraph 2 above.

7. In response to the Office Action (which included the above-described Request for Information), the Applicants responded by way of a Request for Reconsideration dated July 10, 2006 (with an apparent Office filing date of July 12, 2006) to the rejections under 35 U.S.C. §101 and 112, responded to the 35 U.S.C. §102 rejection over the Technotown reference by stating:

The Technotown reference is very different from the presently claimed invention. The Technotown reference recounts merely providing LEGO® blocks to school children for the building of physical models of cities. There is absolutely nothing in the Technotown reference relating to organizational or business issues and likewise has nothing to do with understanding organizational and relationship issues through the use of narrative

or metaphor. More specifically, there is nothing relating to using “building blocks to serve as physical metaphors” as recited in Claim 1 of the present application, nothing relating to “the topic involves business planning” as recited in Claim 2, nothing relating to “at least one of the metaphors represents a customer of a company”, etc.

8. As the TECHNOTOWN reference was irrelevant to the presently pending claims, the Request for Reconsideration described in paragraph 7 above further traversed the Request for Information with respect to the TECHNOTOWN reference as “misdirected”.

9. On August 1, 2006, the Examiner sent a “Notice of Non-Compliant Amendment”, which stated that a Request for Information could not be traversed and further set the response date in accordance with a final action, stating that the applicant would be given no new time period for response, and that no extensions could be received which were based on the August 1, 2006 date.

10. The present petition is being filed within six months of the NON-FINAL action of April 12, 2006.

POINTS TO BE REVIEWED

1. As the TECHNOTOWN reference is immaterial to the examination of the present application, the Request for Information should be vacated.
2. As the Office Action of April 12, 2006 was non-final, the Notice of Non-Compliant Amendment of August 1, 2006 should have set a new response date, from which extension may be obtained.

ACTIONS REQUESTED

1. The Request for Information should be vacated.
2. The Notice of Non-Compliant Amendment should be vacated based upon the vacating of the Request for Information. Alternatively, as the Office Action of April 12, 2006 was non-final, the Notice of Non-Compliant Amendment of August 1, 2006 should have set a new date for response, based upon the August 1, 2006 date, from which extensions can be obtained (i.e., February 1, 2007, six months after the date of the Notice) or a new Office Action should be mailed, thereby restarting the six month date for response.

Respectfully submitted,



Gerald Levy
Registration No. 24,419

Ronald E. Brown
Registration No. 32,200

Pitney Hardin LLP
7 Times Square
New York, New York 10036-7311
212-297-5800